

U.S.S.N. 09/808,610

Claim 19 is directed to a roll of pressure sensitive adhesive tape that includes a first nontacky edge face, a second edge face, and a coating disposed on the first edge face. The coating includes the reaction product of acrylate oligomer, polyether acrylate oligomer, and optionally monomer, photoinitiator or a combination thereof. It is undisputed that JP '353 fails to teach a roll of pressure sensitive adhesive tape that includes a coating that includes the reaction product of acrylate oligomer, polyether acrylate oligomer, and optionally monomer, photoinitiator or a combination thereof. Instead, JP '353 discloses applying a solvent-based composition on the edge face of the tape, where the solvent-based composition includes crosslinkable photosensitizer or a crosslinkable photosensitizer, a photoactive crosslinking agent and, optionally, a vinyl-based polymer. None of the vinyl-based polymers of JP '353 are the reaction product of acrylate oligomer and polyether acrylate oligomer.

JP '628 does not cure the deficiencies of JP '353. To establish obviousness based upon a proposed combination of references there must be some teaching, suggestion or motivation in the prior art for making the proposed combination. See Fromson v. Anitec Printing Plates, Inc., 132 F.3d 1437 (Fed. Cir. 1997); C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, (Fed. Cir. 1998). Here there is no such teaching, suggestion or motivation. JP '628 discloses an adhesive composition for bonding two substrates together. JP '628 does not teach a detackifying composition. JP '628 also does not teach or suggest using the adhesive composition disclosed therein to detackify the edge face of a roll of pressure sensitive adhesive tape. Accordingly, the skilled artisan familiar with JP '353 would have no reason to look to JP '628 and further would have no reason to modify JP '353 in the manner proposed in the Office action.

JP '628 is further deficient in that nothing in JP '628 directs the skilled artisan to select the specific combination of an acrylate oligomer and a polyether acrylate oligomer for use on the edge face of a roll of pressure sensitive adhesive tape. Accordingly, the skilled artisan would have no reason to *sua sponte* do so. Applicant submits, therefore, that the proposed combination of JP '353 and JP '628 fails to establish a prima facie case of obviousness. Accordingly, the rejection of claim 19 under 35 U.S.C. § 103 over JP '353 in view of JP '628 cannot stand and Applicant requests that it be withdrawn.

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Claims 20-35 are distinguishable over the proposed combination of JP '353 and JP '628 for at least the same reasons set forth above in distinguishing claim 19.

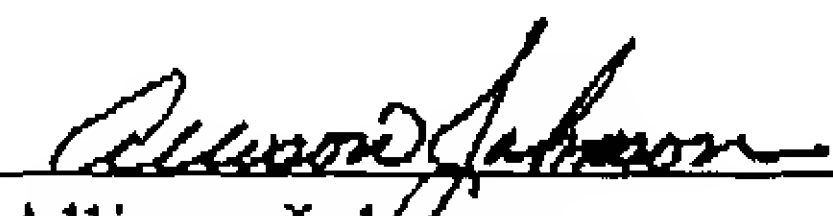
Applicant notes that MPEP 821.01 states that where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected invention or to take appropriate action will be construed as authorization to cancel claims drawn to the nonelected invention or as authorization to cancel those claims by examiner's amendment and pass the application to issue after the expiration of the period for reply. Accordingly, Applicants wish to proceed according to this provision of MPEP 821.01.

The claims now pending in the application are in condition for allowance and such action is respectfully requested. The Examiner is invited to telephone the undersigned should a teleconference interview facilitate prosecution of this application.

Please charge any additional fees owing or credit any over payments made to Deposit Account No. 501,171.

Respectfully submitted,

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